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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,178	01/24/2005	Toshio Shimizu	040894-7167	3575
9629	7590	11/16/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			NASH, BRIAN D	
			ART UNIT	PAPER NUMBER
			3721	
DATE MAILED: 11/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/522,178

Applicant(s)

SHIMIZU ET AL.

Examiner

Brian Nash

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Examiner's Comments

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2006 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 3, the last three lines of each claim are indefinite because it is not clear what applicant is claiming and/or what limitations are encompassed by the claims. Specifically, no frame of reference has been defined such that it is not clear what sides of the staple leg is the "inner side" or is the "base portion". Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the

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treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,209,772 to Wang. Insofar as the claimed invention is understood Wang shows the same invention as claimed:

With respect to claims 1 and 3, a stapler and cartridge combination comprising a strike out passage (243) for guiding staples (5) into sheets (6) wherein the staple legs are folded to bend in right angles from both ends of a crown portion of the staple; a driver plate (111) for striking out the staples through the strike out passage and into the sheets; a clincher mechanism (31, 311) arranged to oppose the driver plate for folding the staples along a rear face of the sheets; and a guide member (123) for supporting a side of a base portion of the staple leg from an inner side of the stapler during the process that the staple legs penetrate the sheets (see column 3, lines 1-10 & column 4, lines 1-5, Figs. 1-5a,b). The additional cartridge claimed in 3 is shown in Figs. 4 & 5a wherein the staples (5) are in a cartridge that is mounted into a cartridge basket (24) of the stapler assembly.

With respect to claim 2, the guide member (123) includes a guide piece disposed in the strike out passage (see Figs. 5a,b, not separately numbered) and an inclined face formed to the guide piece (column 4, lines 6-16); and wherein the guide member (123) moves in the direction of escaping from the strike out passage and the inclined face is brought into contact with the crown portion of the staple.

With respect to claim 5, Wang shows the stapler and cartridge combination wherein the guide member (123) includes a guide piece disposed in the strike out passage (see Figs. 5a,b, not separately numbered) and an inclined face formed to the guide piece (column 4, lines 6-16); and wherein the guide member (123) moves in the direction of escaping from the strike out passage and the inclined face is brought into contact with the crown portion of the staple.

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6. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,651,491 to Heaton et al. Insofar as the claimed invention is understood Heaton et al show the same invention as claimed:

With respect to claims 1 and 3, a stapler and cartridge combination comprising a strike out passage (slots shown in cartridge 22, not numbered – see Fig. 6) for guiding staples (24) into tissue sheets wherein the staple legs are folded to bend in right angles from both ends of a crown portion of the staple; a plurality of driver plates (26) for striking out the staples through the strike out passage and into the tissue sheets; a clincher mechanism (anvil 90, 91 – see Fig. 12) arranged to oppose the driver plates for folding the staples along a rear face of the sheets; and a guide member (slot wall seen in Fig. 6b, not numbered) for supporting a side of a base portion of the staple leg from an inner side of the stapler during the process that the staple legs penetrate the tissue sheets. The additional cartridge (22) claimed in 3 is shown in Fig. 6 wherein the staples (24) are in a disposable cartridge that is mounted to the stapler assembly.

With respect to claim 4, the guide member (slot wall seen in Fig. 6b, not numbered) is integrally molded to be single-piece with the cartridge (22).

Response to Arguments

7. *In re* amended claims 1 and 3, applicant's arguments filed 10/27/2006 have been fully considered but they are not persuasive. Applicant contends, *inter alia*, that the guide member of Wang and Heaton et al does not perform the same function as the claimed invention. Examiner acknowledges applicant's position; however, a reference is deemed to properly anticipate a claim when all the recited limitations are disclosed therein. In this instance, the guide member of both Wang and Heaton et al clearly shows all the recited structural limitations. While it is noted that the device of Wang and Heaton et al may not perform the same function in the same way as applicant's invention, it is deemed that applicant's claims are not restrictive to such device.

Additionally, in response to applicant's argument that neither Wang nor Heaton et al disclose a guide member for supporting a side of a base portion of the staple leg from an inner side of the staple

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during a process that the staple leg is penetrating the sheets, the Examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this instance, both Wang and Heaton et al clearly show a guide member capable of supporting a portion of the staple leg during a stapling process. Furthermore, the terminology "a guide member with substantially parallel lateral sides" added via applicant's request for continued examination is not clear and requires correction in order to understand what structural limitations are encompassed by the claims.

For the reasons above, the grounds for rejection are deemed proper.

8. It is noted that US 3,291,357 to Ruskin has not been cited in the arguments above; however, the Examiner makes reference to its similarity to applicant's claims in an effort to further prosecution of the application.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 6 p.m.


11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467. The official fax number for this Group is: 571-273-8300

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/12/2006


Brian Nash